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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,823	06/30/2003	Kiyoshi Uchida	13797-002002 / PH-393US	3073
20985	7590	10/18/2006	EXAMINER DEJONG, ERIC S	
FISH & RICHARDSON, PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			ART UNIT 1631	PAPER NUMBER

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	Application No. 10/611,823	Applicant(s) UCHIDA, KIYOSHI	
	Examiner Eric S. DeJong	Art Unit 1631	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 05 October 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see continuation sheet. (See 37 CFR 1.116 and 41.33(a)).

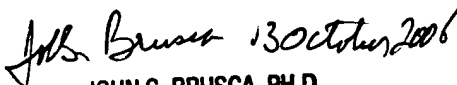
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☒ Applicant's reply has overcome the following rejection(s): see continuation sheet.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_  
Claim(s) objected to: \_\_\_\_\_  
Claim(s) rejected: 8-25.  
Claim(s) withdrawn from consideration: \_\_\_\_\_

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see continuation sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_

  
**JOHN S. BRUSCA, PH.D**  
**PRIMARY EXAMINER**

EDJ



## Continuation of Item 3. NOTE:

Applicants proposed after final amendments to the instant claims introduce substantive changes that raise new issues requiring further search and consideration, and therefore will not be entered. The proposed amendments introduce several additional process steps drawn to sequence selection and evaluation of independent claim 8, from which claims 9 and 11-17 depend.

## Continuation of Item 5. NOTE:

The rejection of claims 11-17 and 19-25 under 35 USC 112, first paragraph, as failing to comply with the written description requirement as set forth in the Office action, mailed 07/11/2006, is withdrawn in view of arguments presented by applicants, filed 10/06/2006.

## Continuation of Item 11. NOTE:

The remaining rejections set forth in the Office action, mailed 07/11/2006 are maintained for reasons of record.

Claims 8-25 are rejected under 35 USC 112, first paragraph, as failing to comply with the enablement requirement. If entered, applicants proposed after final amendment would be sufficient to overcome the basis of the instant rejection.

Claims 8-25 are rejected under 35 USC 112, second paragraph, as being indefinite.

If entered, applicants proposed after final amendment would be sufficient to overcome the basis of the instant rejection. Upon review of the proposed amendments to the instant claims, steps (a) and (b) of claim 8 recites the selection of a first and second pair of sequences from given pair of sequences. Steps (d) through (f) of claim 8 further recite limitations drawn to iteratively extending the selected sequences until a final first and second sequences are selected. Therefore, steps (a) through (f) involve the selection of an initial set of first and second sequences, a plurality of intermediate sets of first and second sequences, and a final set of first and second sequences. Due to the plurality of different first and second sequences, as well as the identification of an intervening region of nucleotides between the initial set of first and second sequences (as set forth in steps (a) and (b)), the antecedent basis for limitations drawn to a "first sequence", a "second sequence", "one or more regions", and "a region" as recited in steps (i) through (j) are unclear.